

C.J.
11/4/99



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/648,676	05/16/96	LEADER	M 2227-006

EXAMINER

IM41/0104

BRUCE W GREENHAUS
BAKER MAXHAM JESTER & MEADOR
750 B STREET SUITE 3100
SAN DIEGO CA 92101

TUNG T ART UNIT PAPER NUMBER

18

1744

DATE MAILED: 01/04/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 11-19-98

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) i-17, 19-21 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
 Claim(s) _____ is/are allowed.
 Claim(s) i-17, 19-21 is/are rejected.
 Claim(s) _____ is/are objected to.
 Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
 The drawing(s) filed on _____ is/are objected to by the Examiner.
 The proposed drawing correction, filed on _____ is approved disapproved.
 The specification is objected to by the Examiner.
 The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 All Some* None of the CERTIFIED copies of the priority documents have been
 received.
 received in Application No. (Series Code/Serial Number) _____
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Application/Control Number: 07/648,676

Art Unit: 1102

Claims 1-17, 19-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The expression "primary support" newly-added to the independent claims (claim 1, line 3; claim 19, line 6) does not appear to have basis in the original disclosure in concept or words. Applicant is reminded that the test for disclosure is not what may be obvious, but what was actually disclosed.

Claims 6, 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is unclear what is an encasement material reducing cell. Does applicant mean that a cavity or recess is formed so as to use less of the encasement material? If so, what does that have to do with the encasement material absorbing moisture, as discussed at page 35, line 14 of the specification?

Claims 1-17, 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1102

The expression "primary support" newly-added to the independent claims is vague.

Applicant appears to be relying on this term as calling for a support with a thickness or bulk larger than a coating support. It is unclear what are the dimensions of such thickness or bulk.

Claims 1-3, 6-13, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Betts et al in view of Knudson et al and Brown et al, with or without Europe '629.

Applicant argues that his newly-added expression "primary support" distinguishes over coating structures that support the electrodes in Brown and Europe.

This argument is not persuasive. First, as discussed before, the expression "primary support" is not seen to be supported by the original disclosure. Second, the layer on which the electrodes overlie in Brown or Europe serves the function of supporting the electrode. Whether that layer is a "primary" support or not does not detract from the fact that it serves as a support and has a thru-hole directly underneath the electrode.

Applicant also argues that there is no motivation to modify Betts by providing the thru-hole directly underneath the electrode. This argument is also not persuasive. As discussed in the previous Office action, if the thru-hole is spaced away from the electrode, the conductor would have to be located on the analyte side of the sensor from the electrode to the thru-hole. This would expose the conductor to the corrosive environment of the analyte as well as the added risk of leakage.

Applicant further argues that the specific dimensions of his electrode and the thru-hole are not taught by the reference. This argument is further not persuasive. The dimensions disclosed in

Art Unit: 1102

the references are very close to those of applicant's claimed device. It is well-settled that dimension is a matter of routine optimization in the absence of unexpected result.

Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Betts et al in view of Knudson et al and Brown et al, with or without Europe '629 and Grubb.

The arguments here are similar to those of the first prior art rejection and are similarly non-persuasive here. Additionally, applicant argues that the elongated tubular electrode of Grubb can not be mounted on a planar surface of a substrate such as that of Betts. This argument is not persuasive. Grubb is relied on merely to show that a gel electrolyte for electrolytic sensors is well-known for rendering the sensor position-insensitive. The shape of the Grubb electrode is irrelevant.

Claims 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Betts et al in view of Knudson et al and Brown et al, with or without Europe '629, and Buzzia.

Applicant additionally argues that Buzzia does not disclose a flow channel with a dome shape that increases the volume about an oxygen sensor. This argument is not persuasive and appears to be based upon a misinterpretation of the Buzzia patent. Element 18 is clearly an oxygen sensor (see col. 8, line 30). From figure 8 and col. 9, line 13 of Buzzia, it is evident that the flow channel is in the form of a dome that certainly has a larger volume than the channel 278-276. This dome serves to accommodate the convex end 246 of the oxygen sensor 18.

Claims 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Betts et al in view of Knudson et al and Brown et al, with or without Europe '629, and Pace '410 and Kuhn et al.

Art Unit: 1102

Applicant additionally argues that Pace and Kuhn do not suggest the directly-under location of the thru-hole. This argument is not persuasive in that these references are relied on only to show the various sensors recited in claim 16 to be conventional.

Co-pending applications SN 08/648,675; 08/648,649; 08/649,009 are related to the instant application. In the event this application ever becomes allowable, applicant presumably would submit terminal disclaimer(s) of any of these applications that have become patents or allowable. Applicant is requested to confirm his intention to do so in his next response. Failure to do so would be construed as applicant's acquiescence in this matter.

The examiner can be reached at 703-308-3329. His supervisor Robert Warden can be reached at 703-308-2920. Any inquiry of a general nature should be directed to the receptionist at 703-308-0661.



Ta Tung

Primary Examiner

Art Unit 1744